



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/585,876	07/11/2006	Dieter Foerster	291734US6PCT	7713

22850 7590 02/22/2010
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

FLETCHER III, WILLIAM P

ART UNIT	PAPER NUMBER
----------	--------------

1792

NOTIFICATION DATE	DELIVERY MODE
-------------------	---------------

02/22/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com
oblonpat@oblon.com
jgardner@oblon.com

Office Action Summary	Application No. 10/585,876	Applicant(s) FOERSTER ET AL.	
	Examiner William P. Fletcher III	Art Unit 1792	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 November 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-26 is/are pending in the application.
- 4a) Of the above claim(s) 25 and 26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 July 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>7/11/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of claims 14-24 in the reply filed on November 9, 2009, is acknowledged. The traversal is on the ground(s) that, since the International Preliminary Examining Authority did not hold unity lacking, unity is not lacking. This is not found persuasive because the International Preliminary Examining Authority is not *required* to indicate a lack of unity even if such a lack exists as indicated by the conditional language "may" used in, for example, 37 CFR 1.488. It remains the Examiner's position that unity is lacking *a posteriori* as evidenced by the rejections set forth herein below.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 25 and 26 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on November 9, 2009.

Priority

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

4. The IDS filed July 11, 2006, has been considered.

Drawings

5. The drawings were received on July 11, 2006. These drawings are acceptable.

Specification

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT.
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC.
- (f) BACKGROUND OF THE INVENTION.
 - (1) Field of the Invention.
 - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (g) BRIEF SUMMARY OF THE INVENTION.
- (h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (i) DETAILED DESCRIPTION OF THE INVENTION.
- (j) CLAIM OR CLAIMS (commencing on a separate sheet).
- (k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

6. The use of the trademark "Teflon" has been noted in this application (see spec. p. 11, ll. 21-22, for example). It should be capitalized wherever it appears and be accompanied by the generic terminology.

Art Unit: 1792

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

7. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: METHOD FOR CONTINUOUS COATING OF AN INSIDE OF A CONTINUOUSLY EXTRUDED HOLLOW PROFILE STRAND OF ELASTIC MATERIAL.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 14-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. Claim 14

i. The phrase "the hollow chambers" lacks antecedent basis.

ii. The phrase "a rise in a path" is indefinite since it is unclear whether this refers to the earlier-recited "rising in its path" or to another rise altogether.

iii. The term "securely" is a relative term which renders the claim indefinite. The term "securely" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite

Art Unit: 1792

degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The nature and .

B. Claims 18 & 19

i. The trademark "Teflon" is noted in this claim. The relationship between a trademark and the product it identifies is sometimes indefinite, uncertain, and arbitrary. The formula or characteristics of the product may change from time to time and yet it may continue to be sold under the same trademark. In patent specification, every element or ingredient of the product should be set forth in positive, exact, intelligible language, so that there will be no uncertainty as to what is meant. Arbitrary trademarks which are liable to mean different things at the pleasure of manufacturers do not constitute such language. See *Ex parte Kattwinkle*, 12 USPQ 11 (Bd. App. 1931). The second paragraph of 35 USC 112 states: "The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention." Because of the changeable nature of trademarks, the scope of the claim is not clear to a hypothetical person possessing the ordinary level of skill in the pertinent art and, therefore, fails to serve the notice function required by 35 USC 112, second paragraph, by providing clear warning to others as to what constitutes infringement of the patent. See *Solomon v. Kimberly-Clark Corp.*, 216 F.3d 1372, 1379, 55 USPQ2d 1279, 1283 (Fed. Cir. 2000).

Art Unit: 1792

ii. The phrase "at least one wiping lip of Teflon, felt, and/or silicone" is indefinite since "at least" implies the permissibility of elements not recited, but it is unclear what all of the criteria defining which other, unnamed materials may be used, are.

C. Claim 20

The phrase "the hollow chamber" lacks antecedent basis.

D. Claim 21

- i. The phrase "non-magnetic body" lacks antecedent basis.
- ii. The phrase "the hollow chamber" lacks antecedent basis.
- iii. The phrase "the body" lacks antecedent basis.

E. Claim 22

The phrase "wherein a hollow profile strand" is indefinite since the use of indefinite article "a" makes it unclear whether this is the same strand as previously recited in claim 14, or another strand.

F. Claim 23

The phrase "wherein plural layers are applied" because it is unclear precisely what sort of layers are being referred to: plural layers of what?

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

12. Claims 14-17, 20, and 22-24 rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0 530 617 A1 in view of US 2,100,587 A.

A. Claim 14-16

i. Both of these references were cited and applied in PCT/EP2004/014709 of which the instant application is the National Stage Entry. Consequently, the references should be familiar to Applicant.

ii. EP '617 teaches the claimed process of coating an extruded hollow section with the exception of the claimed wiping step.

iii. US '587 teaches a process for wiping a coating from the inside of a hollow member using the claimed wipers having a magnetic material and a wiping lip held at a constant position by counter magnets, clearly illustrated in the figures. Use of such members serves not only to aid in the removal of excess coating material, but also serves to smooth the coating on the walls [2:4-8].

Art Unit: 1792

iv. It would have been obvious to one skilled in the art to modify the process of EP '617 so as to utilize the wiping member of US '587, in the fashion of US '587. One skilled in the art would have been motivated to do so by the desire and expectation of successfully improving removal of excess coating as well as improving the smoothness of the coating applied.

B. Claim 17

i. Neither of these references specifies the magnetic material used.

ii. It is the Examiner's position that any one magnetic material would be just as suitable as any other magnetic material as they would all serve to secure the wiping device.

iii. Consequently, since there appears to be no criticality to the magnetic material, either in the references or the instant application, it would have been obvious to one skilled in the art to utilize any magnetic material — including the claimed Ni-Fe-B magnets — motivated by the desire and expectation of successfully securing the wiping device.

C. Claim 20

i. US '587 further teaches that the wiping element may be combined with a coating element in the fashion claimed [2:54+].

ii. While US '587 does not expressly teach that the coating element is impregnated with coating material, foamed materials impregnated with a

Art Unit: 1792

coating material are known in the coating art as useful for the application of coating materials to surfaces.

iii. Consequently, use of an impregnated, foamed material, would have been a readily obvious means of application of the coating material and its substitution in the above method would have been a readily apparent means of simplifying the process (i.e., no nozzle cap, etc.).

D. Claims 22 & 23

i. Neither of these references teaches the specific structure of the hollow member.

ii. Nevertheless, it is the Examiner's position that this combination of references is suitable for and may advantageously be used to coat the inner surfaces of hollow members having any configuration, absent evidence to the contrary.

E. Claim 24

While not expressly taught by the references, it is well known in the art to repeat application of a coating material in order to build up a coating of a desired thickness.

13. Claims 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0 530 617 A1 in view of US 2,100,587 A, as applied to claim 14 above, further in view of JP 06-063504 A.

A. Neither EP '617 nor US '587 teach the materials recited in these claims.

B. Claim 18

Art Unit: 1792

i. JP '504 teaches that it is known to use foams or silicone material to wipe/smooth coating material along the inner surface of a pipeline [0016].

ii. Consequently, it would have been readily apparent to utilize, as the wiping member of US '587, a foamed or silicone member. One skilled in the art would have been motivated to do so by the desire and expectation of successfully smoothing and removing coating material.

C. Claim 19

i. None of these references teaches an ePTFE foam of the claimed density.

ii. It is the Examiner's position that the type of foam material used as the applicator is not critical. As such, an material capable of applying coating material — including the claimed ePTFE — would have been readily apparent to one skilled in the art.

14. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0 530 617 A1 in view of US 2,100,587 A, as applied to claim 14 above, further in view of US 4,393,805 A.

A. Neither EP '617 nor US '587 teach that the applicator has rollers fastened to the body.

B. US '805 teaches a device for coating and spreading coating material on the inside surfaces of a pipe that uses rollers to allow movement through the pipe [see Figs., for example].

Art Unit: 1792

C. Consequently, it would have been obvious to one skilled in the art to modify the process of the above combination of references to include rollers so as to facilitate movement within the pipe.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William P. Fletcher III whose telephone number is (571) 272-1419. The examiner can normally be reached on Sunday, 5:00 AM - 12:00 PM and Monday through Friday, 5:00 AM - 3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy H. Meeks can be reached on (571) 272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Application/Control Number: 10/585,876

Page 12

Art Unit: 1792

/William Phillip Fletcher III/

Primary Examiner, Art Unit 1792

February 11, 2010